

### REMARKS

The application has been reviewed in light of the Final Office Action mailed January 5, 2004. Claims 33, 35, 37, 38, 40, 42, 43, and 71-95 are pending in this application. Claims 33, 35, 37, 38, 40, 42, 43, and 71-95 were rejected. Applicants previously cancelled Claims 1-32, 34, 36, 39, 41, and 44-70 and added new Claims 71-95.

#### **Rejections under 35 U.S.C. § 102**

Claims 33, 35, 37-38, 40 and 71-91 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,498,841 issued to Rex Norman Bull et al. ("Bull"). Applicants respectfully traverse and submit that the Examiner's rejection of Applicants' invention based on the teachings of Bull is misplaced.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the Bull reference cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because Bull does not show all the elements of the presented claims.

Bull discloses a method and system for providing audible call notification of a current call and a subsequently received call waiting call to a called party. In Bull, a called party, on an existing telephone call or upon answering a current call, is provided an enhanced call waiting message that includes a call waiting indicator and an audible representation of caller ID information, i.e., a text-to-speech conversion of the calling number and the party associated with the calling number or an identifying utterance obtained from the calling party. In addition, the called party is presented with calling party's standard caller ID information on any Type II caller ID customer premises equipment, i.e., equipment capable of receiving both standard caller ID and caller ID for call waiting information, in use by the called party. In response to a determination that caller ID information for the calling party is not available, the Bull system provides an audible prompt to the calling party requesting that the calling

party provide an identification utterance. Alternatively, the request for calling party identification may be displayed on customer premises equipment of the calling party.

During an existing telephone call or upon answering a current call, the called party is also presented with a set, audible listing of call disposition options from which the called party may select to dispose of a call waiting or current call. The set, audible listing of call disposition options in Bull, thus, is presented in response to an off-the-hook state of the called party's telephone. The audible set of predefined call disposition options disclosed in Bull includes rejecting or accepting the call waiting call, forwarding the call waiting call to an answering service or voicemail, sending a sales refusal and blocking the call waiting call. If the called party on an existing telephone call does not select a disposition option from the audible listing, the call waiting call is directed to voicemail or an answering service. Similarly, if the called party does not answer a current telephone call, the calling party on the current call is directed to a voicemail device or answering service for the called party.

Claim 33 includes, among other operations, "automatically preparing, by the mediation system, a list of follow-through options, based on the contextual information". Bull fails to teach, suggest or otherwise disclose preparing a list of follow-through options based on the contextual information. In contrast, Bull provides a message to the called party including a call independent, standard set of "disposition options" for the call and audible instructions allowing the called party to accept or reject the call, block the calling number, transmit a message to the calling party or route the call to a voicemail system. As such, only the communication of standard "caller ID" information, text-to-speech versions of "caller ID" information and/or recordings obtained from the calling party are related to specific characteristics of particular call while the call disposition options audibly presented to the called party are predefined and call independent. Further, the provision of an enhanced caller ID message and call disposition options to a called party as described in Bull occurs in response to the called party's telephone being in an off-the-hook state, not in response to receiving a request for voice based communication as claimed in Claim 33. As such, Bull fails to anticipate "automatically evaluating, by the mediation system, contextual information associated with the telephone call, in response to receiving the request for voice-based communication" as claimed in Claim 33. In addition, Bull fails to anticipate a method for facilitating mediated virtual communication comprising, among other operations, "automatically preparing, by the mediation system, a list of follow-through options, based on

the contextual information" as claimed in Claim 33. Accordingly, Bull fails to anticipate each and every element of Applicants' Claim 33.

In addition to the operations listed above, Claim 33 also includes "automatically transmitting a message from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party". As mentioned above, Bull discloses an "efficient and effective method and system for providing to a customer an audible call notification of a current call and a subsequently received call waiting call" as well as a set, call independent, audible listing of call disposition options.

The Examiner cites column 9, line 13, referencing "audible instructions", column 10, line 44, referencing "the display", and column 9, lines 7-35, referencing "for selection by the called party", as anticipatory of the limitation presented in Applicant's Claim 33 involving a message delivered to a called party's communication device wherein the message includes a list of follow-through options to be displayed for selection by the called party. The Examiner's cites are misplaced in a first respect as audible instructions, the only form of disposition instruction discussed in Bull, cannot be displayed on the communication device of the called party. The Examiner's cites are misplaced in a second respect in that "the display" discussed at column 10, line 44 is that of the display of conventional caller ID information, e.g., telephone number and name of calling party. Accordingly, Bull fails to anticipate a method for facilitating mediated virtual communication comprising, among other steps, "automatically transmitting a message from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party" as claimed in Claim 33.

Similar to Claim 33, Claim 81 includes, among other elements, computer instructions for "automatically preparing a list of follow-through options, based on the contextual information" associated with a telephone call. As described above, Bull provides a message to the called party including call independent, standard "disposition options" for the call and audible instructions allowing the called party to accept or reject the call, block the calling number, transmit a message to the calling party or route the call to a voicemail system. Further, the provision of an enhanced caller ID message and call disposition to a called party as described in Bull occurs in response to the called party's telephone being in an off-the-

hook state, not in response to receiving a request for voice based communication as claimed in Claim 81. As such, Bull fails to anticipate "automatically evaluating contextual information associated with the telephone call, in response to receiving the request for voice-based communication" as claimed in Claim 81. In addition, Bull fails to anticipate a program product for facilitating mediated virtual communication comprising, among other elements, "automatically preparing a list of follow-through options, based on the contextual information" as claimed in Claim 81. Accordingly, Bull fails to anticipate each and every element of Applicants' Claim 81.

Also similar to Claim 33, Claim 81 includes, among other elements, computer instructions for "automatically transmitting a message from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party". As mentioned above, Bull discloses an "efficient and effective method and system for providing to a customer an audible call notification of a current call and a subsequently received call waiting call". Bull does not teach, suggest or otherwise disclose the display of the disposition options discussed therein on the communication device of the called party for selection by the called party. As such, Bull fails to anticipate the display of follow-through options on a called party's communication device for selection as claimed in Claim 81.

In light of the arguments presented above, Applicants respectfully request that the Examiner reconsider the rejection to Claim 33, withdraw the rejection and allow Claim 33. Likewise, Applicants respectfully request that the Examiner reconsider the rejection to Claim 81, withdraw the rejection and allow Claim 81.

Claims 35, 37, 38, 40, and 71-80 depend from and provide further patentable limitations to independent Claim 33. Claims 82-91 depend from and provide further patentable limitations to independent Claim 81. Accordingly, Applicants respectfully request that the Examiner reconsider the rejections to Claims 35, 37, 38, 40, 71-80 and 82-91, withdraw the rejections and allow Claims 35, 37, 38, 40, 71-80 and 82-91.

**Rejections under 35 U.S.C. § 103**

Claims 42-43 and 92-95 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bull in view of U.S. Patent 6,477,240 issued to Kang S. Lim et al. ("Lim"). Applicants respectfully traverse.

A finding of obviousness under 35 U.S.C. §103(a) requires a demonstration of the scope and content of the prior art, the level of ordinary skill in the art, differences between the claimed subject matter and the prior art, and whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. Deere*, 383 U.S. 1 (1996). The relevant inquiry is whether the prior art both suggests the invention and provides one of ordinary skill in the art with a reasonable expectation that the suggestion would work. *In re O'Farrell*, 853 F.2d 1549, 7 USPQ2d 1673 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art and not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In determining whether a claimed invention is obvious in light of a combination of references, the court must be vigilant not to allow hindsight to cloud the question. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001) (citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997)). To prevent such "hindsight invalidation," courts require that there be some teaching, suggestion, or reason to combine cited references that are alleged to render the patent claim obvious. *McGinley*, at 1351. Whether such a motivation to combine prior art references has been demonstrated is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir.), cert. denied, 530 U.S. 1238 (2000).

In an attempt to reach elements of the Applicants' invention, the Examiner combines the teachings of Bull and Lim. Applicants respectfully assert that the Examiner's combination is misplaced.

Lim discloses a unified messaging system. As described in Lim, a unified messaging system unifies the various communication services that have, up to now, existed as separate services and permits a user to employ a single device, e.g., a telephone, to access the various communication services such as facsimile, page, email and the like. (col. 6, ll. 12-17) The unified messaging system of Lim is operable to receive a variety of communication connections, identify the type of communication being attempted, e.g., fax, email, page,

voice, etc., and to process the communication connected in accordance with preexisting user communication option settings and without user intervention in all circumstances.

Claim 92 includes, among other elements, computer instructions for "transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device to display the list of follow-through actions for selection by the user". As mentioned above, Bull discloses communicating audible call disposition options to a called party while the called party is on an existing call or in response to a called party answering a current call and the display of standard caller ID information in association with a current or call waiting call. Lim does not disclose, teach or otherwise suggest the presentation of a list of follow-through, disposition or other options to a called party in response to a communication request. In the unified message system of Lim, call disposition options must be defined by the unified message system subscriber prior to receipt of a communication request by the unified message system for such disposition options to operate. Accordingly, Bull and Lim, alone or in combination, fail to teach, suggest or otherwise disclose "transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device to display the list of follow-through actions for selection by the user" as claimed in Claim 92.

Claim 92 also includes, among other elements, displaying a list of follow-through actions for selection by the user, "wherein the list of follow-through actions comprises an option to return a call". The disposition options disclosed in Bull include accepting a call, rejecting a call, blocking a call, routing a call to voicemail, send a sales refusal, and blocking the calling party. The unified messaging system of Lim is directed to handling communication connection attempts without user intervention, other than the unified messaging system user establishing a preferred set of communication disposition parameters at the initiation of unified messaging system use. While the Examiner points out in Lim the ability of the Lim unified message system to make outbound calls, such is not the same as displaying a list of follow-through options wherein one of the follow-through options displayed is an option to return a call as recited in Claim 92. As such, Bull and Lim, alone or in combination, fail to teach, suggest or otherwise disclose displaying a list of follow-through actions for selection by the user, wherein the list of follow-through actions comprises an option to return a call. Accordingly, as neither Bull nor Lim disclose displaying a list of

follow-through actions for selection by the user wherein the list of follow-through actions includes an option to return a call, neither nor Bull nor Lim, alone or in combination, teaches, suggests, or otherwise discloses "transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device to display the list of follow-through actions for selection by the user, wherein the list of follow-through actions comprises an option to return a call" as claimed in Claim 92.

Claim 94, similar to Claim 92, includes, among other elements, computer instructions for "transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device display the list of follow-through actions for selection by the user, wherein the list of follow-through actions comprises an option to return a call". As mentioned above, neither Bull nor Lim, alone or in combination, discloses, teaches or otherwise suggests displaying a list of follow-through actions on a user communication device for selection by the user as claimed in Claim 94. Further, neither Bull nor Lim, alone or in combination, discloses, teaches or otherwise suggests displaying a list of follow-through options on a user communication device for user selection where the list of options includes the option to return a call as claimed in Claim 94.

In light of the arguments presented above, Applicants respectfully request that the Examiner reconsider the rejection to Claims 92 and 94, withdraw the rejection and allow Claims 92 and 94.

Claim 93 depends from and provides further patentable limitations to independent Claim 92. Claims 42, 43 and 95 depend from and provide further patentable limitations to independent Claim 94. Accordingly, Applicants respectfully request that the Examiner reconsider the rejections to Claims 42, 43, 93 and 95, withdraw the rejections and allow Claims 42, 43, 93 and 95.

#### **Information Disclosure Statement**

Applicants enclose a new Information Disclosure Statement and PTO Form 1449 for the Examiner's review and consideration. Applicants received an Office Action in co-pending Application Serial Number 10/096,261 filed March 12, 2002 (Attorney Docket No. 073612.0111), where the Examiner cited new references. Applicants submit the reference

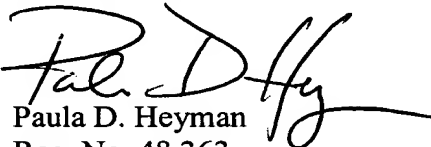
not previously cited in this application for consideration. A check in the amount of \$180.00 is also enclosed for the filing fee.

### CONCLUSION

Applicants appreciate the Examiner's attention to the application. Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of Claims 33, 35, 37, 38, 40, 42, 43, and 71-95 now pending.

Applicants believe no further fee is due at this time. However, if any additional fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

Respectfully submitted,  
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